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OFFICE OF PETITIONS

In re Application :
Edwards, et al. : DECISION ON APPLICATION FOR
Application No. 09/591,307 : PATENT TERM ADJUSTMENT
Filed: June 9, 2000 :
Attorney Docket No. 2685.2001-000 :
:

This letter is in response to the "REQUEST FOR RECONSIDERATION OF THE PATENT TERM ADJUSTMENT UNDER 37 C.F.R. 1.705," filed April 19, 2004. Applicants request that the initial determination of patent term adjustment under 35 U.S.C. 154(b) be corrected from three hundred eight (308) days to three hundred seventy-six (376) days.

The application for patent term adjustment is **DISMISSED**.

On January 27, 2004, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above identified application. The Notice stated that the patent term adjustment (PTA) to date is three hundred eight (308) days. On April 19, 2004, Applicants timely¹ submitted an application for patent term adjustment, asserting that the correct number of days of PTA at the time of the mailing of the Notice of Allowance is three hundred seventy-six (376) days.

¹ Applicants filed the application for patent term adjustment on the same date as they filed the issue fee.

Applicants assert entitlement to a patent term adjustment of three hundred seventy-six (376) days on the basis that the PTO improperly assessed Applicants delay of sixty-eight (68) days pursuant to 35 U.S.C. 154(b)(2)(C)(ii) and 37 C.F.R. 1.704(b).

Applicants state that the patent issuing from the application is not subject to a terminal disclaimer.

The Office initially determined a patent term adjustment of three hundred eight (308) days based on an adjustment for PTO delay of four hundred nineteen (419) days pursuant to 35 U.S.C. 154(b)(1)(A)(i) and 37 C.F.R. § 1.703(a)(1), reduced by Applicants' delays of sixty-four (64) days and forty-seven (47) days, both pursuant to 35 U.S.C. 154(b)(2)(C)(iii) and 37 C.F.R. § 1.704(b).

All adjustments have been reviewed and found to be correct. A non-final Office action was mailed on October 2, 2002. As this date was more than fourteen months after the filing date of the application, PTO delay of 419 days was properly assessed. Applicants filed an amendment in response to the non-final Office action on March 7, 2003. As this date was more than three months later, Applicant delay of 64 days was properly assessed. Finally, a final Office action was mailed on May 13, 2003. Applicants did not file a response (an Amendment and Notice of Appeal) until September 29, 2003, resulting in Applicant delay of 47 days.²

In view thereof, the correct determination of patent term adjustment at the time of the mailing of the Notice of Allowance is **three hundred eight (308) days** (419 days of PTO delay and 111 (64 + 47) days of applicant delay).

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e).

The application file is being forwarded to the Office of Patent Publication for processing into a patent.

² Applicants state that they "filed" the Amendment and Notice of Appeal on September 25, 2003, presumably because they included a Certificate of Mailing dated September 25, 2003. However, under 37 C.F.R. § 1.703(f), "the date indicated on any certificate of mailing or transmission shall not be taken into account" in the PTA calculation. See also Changes to Implement Patent Term Adjustment under Twenty-Year Patent Term; Final Rule, 1239 OG 14 (Oct. 3 2000).

Telephone inquiries specific to this matter should be directed to Cliff Congo, Petitions Attorney, at (571)272-3207.

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for

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